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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,180	08/27/2003	Jay S. Walker	98-076-C1	5244

22927 7590 03/28/2006

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EXAMINER	
PIERCE, WILLIAM M	
ART UNIT	**PAPER NUMBER**
3711	

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/649,180	WALKER ET AL.	
	Examiner	Art Unit	
	William M. Pierce	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-13,15-21,23-27 and 29-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-13,15-21,23-27 and 29-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

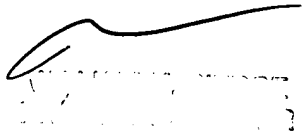
a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 26 and it dependant claims are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim now recites that "any one of the nodes is selectable at the start of a game". Applicants invention shows nodes of start elements 106, 108, 1 10, 1 12, 1 14 and finish elements 1 16, 1 18, 120, 122, 124. Not "any one" of the nodes are selectable at the start of the game as called for in claim 26. For example one could not select nodes 116, 118, 120, 122 or 124. As such there exists insufficient disclosure for such a limitation.

Claim Rejections - 35 USC § 102

Claims 1-3 5-11 13 15 16 17 18-21 23-27, 29-33 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Riendeau 6,761,633 whose, based on his provisional application, has an effective filing date of 6/2/2000 as set forth in the previous office action.

As to claims 1, 5-7, 10, 19-21, 26, 27, 29-31 Riendeau snows a "lottery ticket" a plurality of symbols 16 "printed " in a play area, with a continuous path 14 that is associated with a prize as shown in fig. 2G. The symbols are printed in such a way that the symbols do not have a link between them as shown in fig. 2A at nodes 01 and 16. At col. 3, ln. 38 Riendeau shows associating a prize. While nothing in the claims recites any structure to give any weight to the term Scratch-off and "thicket". Applicant may believe that the implied printed paper with removable material to conceal it is distinguishable over this applied art. However, it is considered well known to make either electronic or physical embodiments of a game. As to claims 2 and 11, the numbers with the negative signs, such as 76, are considered "void" and are a "non-continuous path" in that they need to be "bypassed" or cause negative points. Riendeau electronic embodiment covers his indicia through the programming. To have used a latex covering as called for by claims 3 and 13 would have been obvious in order to make a traditional "lottery ticket". Making manual or automating a manual activity has been held as a non-patentable advance. In re Venner, 262 F.2d 91, 95 replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. As to claim 6, 15 and 16, different path are associated with different prizes. As to claims 8, 9, 17, 18, 32 and 33, Riendeau uses a computer readable medium with a storage device. Claims 23-25 are inherent in Riendeau. Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

Claim Rejections - 35 USC § 103

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Riendeau in view of Sultan 6,273,817 as set forth in the previous office action.

Response to Arguments

Applicant's arguments filed 1/3/06 have been fully considered but they are not persuasive.

A. Claim Amendments

Claims amendments have been noted

B. Section 101

With respect to the issues under101, the steps of "causing a plurality of symbols to be printed" to be the same as "printing a plurality of symbols". Such are considered to be physical steps that render a product by the process .

C. 102(e)/103

1. Applicable Law

Case law recited is noted. However, it is not stated how such law relates to the limitations in the claims. As such no further response is deemed necessary.

2. Independent Claims 1, 8-10 and 17-19

With respect to claim 1, such is a product by process claim. The limitation that "any one of the play symbols is selectable at the start of the game" is drawn only to the method of intended use or play and as such cannot distinguish over the applied art. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

Claims 8 and 9 incorporate claim 1 and too are interpreted as apparatus which must distinguish over the prior art in terms of structure rather than intended use.

Likewise claims 17 and 18 fail to distinguish over the applied art.

3. Claims 2 and 11

Claim 2 merely calls for "causing at least one void symbol to be printed..." with no further structure. A "void symbol" is most broadly any symbol. Nothing in claims 2 or 11 recite any structure that distinguishes over the interpretation of the symbols in Riendeau with negative signs as being considered to be "void symbols". Applicant argues how Riendeau plays his game. However, as set forth above, the play of the game fails to distinguish over the applied art.

4. Claims 26, 27 and 29-33

In claim 26, Riendeau shows a pattern of nodes in spaces marked "01" or space marked "16" in his fig. 2A. Any one of these nodes is selectable at the start of the game as called for by claim 26.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (571) 272-4414.

For **official fax** communications to be officially entered in the application the fax number is (703) 872-9306.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.